

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

<b>Serial No.:</b>	10/697,917	<b>Conf. No.:</b>	9643
<b>Filing Date:</b>	30 October 2003	<b>Art Unit:</b>	2194
<b>Applicant:</b>	Tuel	<b>Examiner:</b>	Wu, Qing Yuan
<b>Title:</b>	Method, system and program product for processing a transaction	<b>Docket No.:</b>	RSW920030189US1 (IBMR-0049)

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Applicants respectfully request that a panel of experienced examiners perform a detailed review of appealable issues for the above-identified patent application pursuant to the Pre-Appeal Brief Conference Program. Applicants submit that the above-identified application is not in condition for appeal because the Office has made clear errors in interpreting claimed limitations with respect to compliance with statutory subject matter and failed to establish a *prima facie* case of obviousness based on clear legal and factual deficiencies in the rejections. Claims 1, 3-6, 9-10, 12-15, and 17-25 are pending in this application.

Turning to the rejections, in the Final Office Action, the Office rejects claims 13-17 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In an after final amendment, Applicant amended claim 13 to expressly state that the system is a computer system, which inherently includes computer hardware (e.g., at least one computer, such as computer 12 of FIG. 1). In an Advisory Action, the Office states that the amendment is insufficient to overcome the 101 rejection since “applicant is claiming a hardware/‘computer system’ that only

recites software and software functionalities (i.e. modules, mechanism) alone.” Advisory Action, continuation of 11. However, Applicant notes that, as claimed, the systems are necessarily tangibly embodied in a computer system. For example, for any of the systems to be included in a computer system, it must be tangibly embodied, e.g., as a copy of a software product, special purpose computing hardware, or some combination thereof. As a result, Applicant is not claiming only “software and software functionalities”, but is claiming a tangible embodiment of the systems. Were the claimed systems only “software and software functionalities”, they would not be part of a computer system, but would rather be in the abstract, apart from any tangible embodiment. As illustrated in FIG. 1, an embodiment of each system is software stored in a memory of a computer. As a result, Applicant respectfully requests withdrawal of the rejections of claims 13-17 as allegedly being directed to non-statutory subject matter.

Further, the Office rejects claims 1, 3-6, 9-10, 12-15, and 17-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2004/0215594 (Somogyi) in view of Applicant Admitted Prior Art (AAPA).

With respect to claim 1, Applicant respectfully submits that the Office fails to show that the combination of Somogyi and AAPA even if, *arguendo*, proper, teaches or suggests requesting, after replying to a requester based on preparation responses, one of: a commitment or a roll back of each resource as in claim 1. As previously argued, both Somogyi (reporting results) and AAPA (providing a response to a requester) expressly teach taking the corresponding actions after all resources have been committed/rolled back. After Final Amendment dated 8 November 2007, pp. 7-8. In contrast, the invention of claim 1 requests commitment or roll back after replying to a requester.

Regardless, the Office first alleges that such a change is merely a “design preference”. As previously argued by Applicant, such a holding is improper since the change provides at least one advantage over the prior art, e.g., an amount of time that the requester must wait for a reply is decreased. After Final Amendment, pp. 8-9. Further, the citations used by the Office in support of its holding do not support the Office’s stated reasoning, which itself provides insufficient support for the holding. After Final Amendment, p. 9.

In the Advisory Action, the Office applies an alternative line of reasoning in rejecting claim 1. In particular, the Office alleges that “applicant’s replying step can indicate an implicit reply of successful resource preparation which satisfied the limitation.” Advisory Action, continuation of 11. Here, the Office takes a contrary position with respect to the teachings of Somogyi than presented previously. In particular, the Office previously stated that “Somogyi does not specifically teach replying to a requester based on the preparation responses.” Final Office Action, p. 4, paragraph 10. However, in the current line of reasoning, the Office is alleging that Somogyi implicitly teaches such a feature. As a result, the Office is making inconsistent interpretations of Somogyi.

Further, Applicant notes that Somogyi, absent the teachings of Applicant’s claimed invention, does not provide any support for the Office’s revised interpretation. In particular, neither Somogyi nor the prior art of record includes any discussion about the lack of any reply being an indication of successful resource preparation as alleged by the Office.

Applicant notes that independent claims 9, 13, and 18 include a similar feature as discussed above with respect to claim 1. Further, the Office relies on its reasoning in rejecting claim 1 in its rejections of claims 9, 13, and 18. To this extent, Applicants incorporate the arguments presented above with respect to claim 1, and respectfully request withdrawal of the

rejections of claims 9, 13, and 18 and the various claims that depend therefrom, as allegedly being unpatentable over Somogyi in view of AAPA.

With further respect to claim 25, Applicant notes that neither Somogyi nor AAPA teaches or suggests program code for starting a resource thread for a resource as in claim 25. As previously argued by Applicant, the Office relies entirely on its rejection of claim 5, which in turn relies entirely on its rejection of claim 1 in support of this rejection, which does not cite any portion of Somogyi nor AAPA that allegedly teaches or suggests the claimed feature. In the Advisory Action, the Office alleges that “Somogyi’s teaching of utilizing (i.e. by starting/initiating/assigning) an available thread for handling the resource transaction operation clearly satisfied this limitation”. Advisory Action, continuation of 11. However, Applicant notes that “utilizing available threads”, as expressly taught by Somogyi, is substantially different than starting a thread. In fact, Somogyi teaches against starting a thread since the primary thread “process[es] any commands that were unable to be dispatched to separate threads” (Somogyi, paragraph 0020), rather than starting a thread.

As a result, Applicants respectfully submit that the Office has failed to state a *prima facie* case of obviousness with respect to all the independent claims of the invention. With respect to the dependent claims not specifically referenced herein, Applicants submit that the Office has failed to state a *prima facie* case of obviousness based on the above arguments. Accordingly, Applicants submit that the Office has failed to state a *prima facie* case of obviousness for all of the pending claims.

Applicants respectfully submit that the application is not in condition for appeal. Should the examining panel believe that anything further is necessary to place the application in better

condition for allowance or for appeal, they are requested to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

/John LaBatt/

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